REMARKS

By this amendment, claim 16 has been amended. Claims 16 and 18-20 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is respectfully requested.

Rejection under 35 U.S.C. §112

Claims 16 and 18-20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As presented herein, claim 16 has been amended to recite, in part, "wherein the interface character comprises a comic character face that provides feedback to a user by means of emotional facial expressions configured to communicate (i) a status and (ii) an internal emotional state of the network downloading of the music files" and is thus no longer indefinite. Withdrawal of the rejection is requested.

Rejection under 35 U.S.C. §103

Claim 16 recites a computer readable medium storing a computer program for causing a processing device to perform network downloading of music files, said computer program comprising:

computer readable code for causing said processing device to obtain at least one music preference;

computer readable code for causing said processing device to access at least one network based music file, the music file including at least one music attribute;

computer readable code for causing said processing device to compare the music attribute to the music preference;

computer readable code for causing said processing device to download the music file based on the comparison;

computer readable code for causing said processing device to search for and download additional music attributes of the music file being downloaded; and

computer readable code for causing the processing device to display a progression of network downloading of music files as a function of an interface character, wherein the interface character comprises a comic character face that provides feedback to a user by means of emotional facial expressions configured to communicate (i) a status and (ii) an internal emotional state of the network downloading of the music files.

Support for the amendments to claim 16 can be found in the specification at least in paragraph [0018] on page 5, lines 20-31.

As presented herein, Claim 16 has been amended to more clearly articulate the novel and non-obvious distinct features thereof. For greater understanding and appreciation, as disclosed in the original specification in paragraph [0015] "[a]n embodiment of the invention is illustrated in FIGS. 2a-2d, depicting assorted views of a graphical user interface (GUI) for use with a music gathering application. This embodiment suits the condition that a user *does not need to know all the details about the events that are generated by the downloading* or playing of music files. When the user *takes a quick look* at his or her player, he or she *may only want to roughly know* how well the music gathering progresses. If the progress is unsatisfactory, the user may want to *take actions to resolve* the problem. In the embodiments illustrated as FIGS. 2a –2d, the *GUI* is used *to coordinate and summarize the information complexity* of music gathering and downloading" (emphasis added). In addition, as disclosed in paragraph [0018], "A status tab 235 highlighted in FIG. 2b shows an embodiment for the feedback or current status of a music gathering action. The *numerous aspects* of this *status*, such

as the *number of available servers*, *speed of the download* and the *availability of chart information* are *too complex* to be *visualized* given the *small screen size*, therefore *a comic character face* (character) 240 is used … . The character 240 acts as *an emotional interface*, providing … *feedback* to the user by *means of emotional facial expressions,* to communicate the *status* of the music gathering application … the character 240 expressions … communicate the *internal emotional state* of the music gathering application to the world. The well-being type emotions are mapped to a set of three different emotional expressions: happiness, anger and sadness. In short, all the positive events and actions will result in happiness, all the negative events will result in sadness and all the negative actions will result in anger." (emphasis added). Furthermore, as disclosed in paragraph [0019], "The distinction between an event and an action is based on accountability."

Claims 16 and 18-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkes et al. (US 20020194601, hereinafter referred to as "**Perkes**") in view of Harada (JP 2004191701, hereinafter referred to as "**Harada**") and in further view of Ruebenstrunk (Author: Gerd Ruebenstrunk, Title: Emotional Computer - Computer models of emotions and their meaning for emotion-psychological research (online); Date November 1998, hereinafter referred to a "**Ruebenstrunk**"). Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 16.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Perkes**, **Harada** and **Ruebenstrunk** references cannot be applied to reject claim 16 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains* ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Perkes**, **Harada**, nor **Ruebenstrunk** teaches performing network downloading of music files (e.g., including providing a downloading status for which *numerous aspects* of this *status*, such as the *number of available servers*, *speed of the download,* and the *availability of chart information* are *too complex* to be *visualized* given the *small screen size*) in which an interface character "comprises a *comic character face* that provides feedback to a user by means of emotional facial expressions *configured to communicate* (i) a *status* and (ii) an *internal emotional state* of the network downloading of the music files" (emphasis added) as is claimed in claim 16, it is impossible to render the subject matter of claim 16 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another

compelling reason why the **Perkes**, **Harada** and **Ruebenstrunk** references cannot be applied to reject claim 16 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Perkes**, **Harada**, nor **Ruebenstrunk** teaches, or even suggests, the desirability of the combination since no one of the references teach the specific "*comic character face* that provides feedback to a user by means of emotional facial expressions *configured to communicate* (i) a *status* and (ii) an *internal emotional state* of the *network downloading* of the music files" as specified above and as claimed in claim 16.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 16. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103

should be withdrawn.

Accordingly, claim 16 is allowable and an early formal notice thereof is requested. Dependent claims 18-20 depend from and further limit independent claim 16 and therefore are allowable as well. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claims 16 and 18-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkes et al. (US 20020194601, hereinafter referred to as "**Perkes**") in view of Piepho et al. (US 20030179867, hereinafter referred to as "**Piepho**") and in further view of Ruebenstrunk (Author: Gerd Ruebenstrunk, Title: Emotional Computer - Computer models of emotions and their meaning for emotion-psychological research (online); Date November 1998, hereinafter referred to a "**Ruebenstrunk**"). Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 16.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following reasons.

3. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Perkes**, **Piepho** and **Ruebenstrunk** references cannot be applied to reject

claim 16 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...* (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Perkes**, **Piepho**, nor **Ruebenstrunk** teaches performing network downloading of music files (e.g., including providing a downloading status for which *numerous aspects* of this *status*, such as the *number of available servers*, *speed of the download,* and the *availability of chart information* are *too complex* to be *visualized* given the *small screen size*) in which an interface character "comprises a *comic character face* that provides feedback to a user by means of emotional facial expressions *configured to communicate* (i) a *status* and (ii) an *internal emotional state* of the network downloading of the music files" (emphasis added) as is claimed in claim 16, it is impossible to render the subject matter of claim 16 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

4. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Perkes**, **Piepho** and **Ruebenstrunk** references cannot be applied to reject claim 16 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the*

> *hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Perkes**, **Piepho**, nor **Ruebenstrunk** teaches, or even suggests, the desirability of the combination since no one of the references teach the specific "*comic character face* that provides feedback to a user by means of emotional facial expressions *configured to communicate* (i) a *status* and (ii) an *internal emotional state* of the *network downloading* of the music files" as specified above and as claimed in claim 16.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 16. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 16 is allowable and an early formal notice thereof is requested. Dependent claims 18-20 depend from and further limit independent claim 16

and therefore are allowable as well. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claim 16 is in condition for allowance. Claims 18-20 depend from and further limit independent claim 16 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. Withdrawal of the Final Action and an early formal notice of allowance of claims 16 and 18-20 is requested.

Respectfully submitted,

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